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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,824	12/27/2003	Leslie N. Gilbertson	0103-0047 (ZM0583)	7187

43231 7590 12/08/2004

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EXAMINER

SNOW, BRUCE EDWARD

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 12/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/748,824	Applicant(s) GILBERTSON, LESLIE N.	
	Examiner Bruce E Snow	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-14 and 16-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-13 and 16-19 is/are allowed.
- 6) ☒ Claim(s) 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed November 18, 2004 have been fully considered.

Regarding the rejection of claim 14 under 35 U.S.C. 112, second paragraph, the Examiner's position has been explained in the grounds of rejection below.

Applicant's amendments and arguments overcame the rejection of claims 10-13 and 16-19 in view of Brooks.

Applicant's amendments and arguments overcame the rejection in view of Sekel.

Allowable Subject Matter

Claims 10-13 and 16-19 are allowed.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14, the wall thickness at element 26 (Figure 2) on "the compression" side is clearly less than anywhere on the "tensile side"; it is noted that the thickness at element 26 is adjacent the contact at the bore opening as required in claim 14. What the Examiner believes in the bigger problem is that applicant has reversed the lateral and medial thickness. Referring to applicant's figure 3, the tensile side is the lateral side shown on the right. The lateral side (tensile side) does not have a greater thickness

than the compression or left side. Additionally, the Examiner believes that it is not the applicant's invention to have a thicker side, but rather to have the tensile side have less contact area than the compression side by offsetting the contact longitudinally upward. Please direct the Examiner to the specification for support of claim 14.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by Brooks (5,035,717).

Brooks teaches a modular joint implant including a male/female junction, the implant comprising:

a first component 24 including a bore 26 having a bore opening (**top**) and an interior surface forming a female side of the male/female junction, the bore having longitudinal junction axis;

a second component 12 including a projection including 70 (see at least figure 2) having an exterior surface forming a male side of the male/female junction, the projection being engageable with the bore in a male/female seating arrangement along the junction axis, the male and female sides contacting one another **adjacent** the bore opening, the wall thickness adjacent the contact at the bore opening being greater on the tensile side (top right) of the implant than on the compressive side (top left) of the

implant; 24. (It is noted the Examiner believes the applicant has reverse the medial and lateral sides; this interpretation of Brooks mimics applicant's mistake. Further, the tensile and compressive side can be reversed if necessary).

The term adjacent does not limit too exactly at the bore opening.

Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by McLardy-Smith (5,116,37).

Referring to figure 3, Brooks teaches a modular joint implant including a male/female junction, the implant comprising:

a first component 1 including a bore having a bore opening and an interior surface forming a female side of the male/female junction, the bore having longitudinal junction axis;

a second component 2 including a projection (top end) having an exterior surface forming a male side of the male/female junction, the projection being engageable with the bore in a male/female seating arrangement along the junction axis, the male and female sides contacting one another adjacent the bore opening, the wall thickness adjacent the contact at the bore opening being greater on the tensile side (lateral side, bottom right) of the implant than on the compressive side (medial side, bottom left) of the implant.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

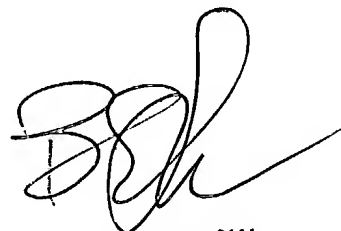
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce E Snow whose telephone number is (571) 272-4759. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3738

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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BRUCE SNOW
PRIMARY EXAMINER